

ATTORNEY DOCKET NO. 046601-5034
Application No. 09/450,584
Page 2

REMARKS

In the Office Action dated October 22, 2003, the previous rejection of claims 1 - 8 under 35 U.S.C. § 103(a) set forth in the prior Office Action dated August 1, 2003, as being unpatentable over Trask (U.S. Patent No. 6,549,303) in view of Kanata *et al.* (U.S. Patent No. 6,473,202), and claim 9 under 35 U.S.C. § 102(e), as being unpatentable over Trask (U.S. Patent No. 6,549,303), has been withdrawn because the translation of the foreign priority papers have been made of record. Claims 1-3 and 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,784,172 to Coleman *et al.* (hereinafter "Coleman"). Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coleman in view of U.S. Patent No. 5,313,570 to Dermer *et al.* (hereinafter "Dermer").

Summary of the Response to the Office Action

Applicant respectfully traverses these rejections and the Office Action's interpretation of the applied references, and respectfully requests reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims.

The Rejection of Claims 1-3 and 6-9 under 35 U.S.C. § 102(b)

Claims 1-3 and 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,784,172 to Coleman *et al.* (hereinafter "Coleman"). Claims 4 - 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Coleman in view of Dermer. Applicant traverses the rejections and the Office Action's interpretation of the applied references for the following reasons.

ATTORNEY DOCKET NO. 046601-5034
Application No. 09/450,584
Page 3

Claims 1, 2, 6, 7, and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Coleman. Coleman describes an image processing device comprising a black area detector that detects a black area in the image data, and an output part that adds predetermined amounts of color, except black, to the black area. Applicant respectfully submits that, as discussed in Coleman at column 6, lines 65 – 67, and as depicted in FIG. 9 of Coleman, image processing step S410 is a decision making process which selectively removes the certain set of image data from going through the additional image analysis. In another words, if Coleman detects an input image data composed of only single-color black, such as text in black color, this data will be bypassed from the further color analysis.

In the present invention, however, an image processing device does not selectively eliminate the non-process colored black objects from the further analysis. Applicant respectfully submits that in the present invention as claimed in independent claims 1, 2, and 7, an output part adds color materials, except black "regardless of contents of the image data in a background of the black area." Moreover, the present invention as claimed in independent claims 6 and 9 discloses image processing methods that includes a step of adding color materials, except black, "regardless of contents of the image data in a background of the black area."

Applicant respectfully submits that Coleman does not teach at least the output part or the step of adding color materials "regardless of contents of the image data in a background of the black area" as recited in independent claims 1, 2, 6, 7, and 9.

As pointed out in MPEP §2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).

ATTORNEY DOCKET NO. 046601-5034
Application No. 09/450,584
Page 4

Accordingly, Applicant respectfully requests that the rejection of claim 1, 2, 6, 7, and 9 under 35 U.S.C. § 102(b) be withdrawn because Coleman fails to teach the image processing method for "black area regardless of contents of the image data in a background of the black area."

Furthermore, Applicant respectfully submits that dependent claims 3 and 8 are not anticipated by Coleman for at least the same reasons as set forth above with regard to independent claims 2 and 7 upon which they respectively depend. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 102(b) rejection of claims 3 and 8 be withdrawn.

The Rejection of Claims 4 and 5 under 35 U.S.C. § 103(a)

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Coleman (U.S. Patent No. 5,784,172) in view of Dermer (U.S. Patent No. 5,313,570). Applicant traverses this rejection and the Office Action's interpretation of the applied references for the following reasons.

Applicant respectfully submits that, in light of the arguments presented above with regard to claims 4 and 5, Dermer fails to cure the deficiencies of Coleman. Accordingly, Applicant respectfully asserts that Dermer and Coleman, whether taken singly or in combination, do not teach or suggest each feature of independent claim 1 upon which claims 4 and 5 respectively depend.

As pointed out in MPEP § 2143.03, "[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

ATTORNEY DOCKET NO. 046601-5034
Application No. 09/450,584
Page 5

Thus, Applicant respectfully submits that claims 4 and 5 are in condition for allowance as Coleman in view of Dermer does not render the claims obvious. Accordingly, Applicant respectfully requests that the rejection of dependent claims 4 and 5 under 35 U.S.C. 103(a) be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 1 - 9. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.


If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 21, 2004

By:


Mary Jane Boswell
Registration No. 33,652

Customer No. 09629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: (202) 739-3000
Facsimile: (202) 739-3001